

Remarks

In view of the amendments and remarks presented herein, favorable reconsideration and allowance are respectfully requested. Claims 1 and 12-19 are hereby amended. Claims 1-20 are pending for examination.

Claims 12-20 stand rejected under 35 U.S.C. §112, as allegedly being indefinite. The rejection of claims 13-20 was based on dependency from claim 12, but Applicant notes that claim 20 is not dependent on claim 12, nor does it suffer from the alleged deficiencies of claim 12. Claims 12-19 have been amended for clarity, and Applicant respectfully requests withdrawal of the rejection of claims 12-20.

Claims 1 and 12 stand rejected under 35 U.S.C. §102(b) as being anticipated by Perry et al. (U.S. App. Pub. 2002/0082882). Applicant submits that Perry does not teach or suggest all elements of the claimed combinations.

For example, claim 1 recites "analyzing the collected data to determine which of the information technology capabilities of each entity are to comprise the information technology capabilities of the entity formed according to the proposed venture transaction."

According to the Office Action, this is taught at paragraphs 59 and 25 of Perry. What Perry actually teaches at the cited portions, however, is that "[a]lternatively, some deals or proposals may be acquisitions of other companies, or portions thereof, or mergers with other companies, or portions thereof." ([0059]). "If the proposal is one where services are offered. . . Services may include. . . information technology services." ([0025]).

Applicant submits initially that the two paragraphs are discussing different types of deals, a contract for services from an IT provider is not the same as a merger or acquisition. When a company contracts out IT services, they have not acquired the IT company or merged with it, rather, they have hired the IT company to provide a service. Therefore, paragraph 59's comment that "alternatively, some deals . . . may be mergers" serves to distinguish the teachings of that paragraph from those of paragraph 25.

Applicant does recognize that the teachings of Perry in general apply to both service contracts and mergers, but Applicant submits the Examiner cannot merely pluck key-words from various paragraphs and string them together in a fashion that then allegedly reads on the claim. The anticipation analysis provided in the Office Action fails to address the language "to

determine which of the capabilities of each entity are to comprise the capabilities of the entity formed." That is, while the Examiner has found the words in Perry relating to IT and to mergers, he has failed to point to any teaching or suggestion that an analysis of a proposed services contract or merger would include "analyzing the collected data to determine which of the information technology capabilities of each entity are to comprise the information technology capabilities of the entity formed according to the proposed venture transaction." Nowhere does Perry mention any sort of analysis to determine which of the IT capabilities of each entity are to comprise the IT capabilities of the entity formed. For example, there is no discussion in Perry of the IT capabilities of any entity formed through a merger, or how each company would contribute to the IT capabilities of a merged entity or joint venture.

Along similar lines, claim 1 also recites "recommending whether to proceed with the proposed venture transaction based upon the information technology capabilities of the entity formed according to the proposed venture transaction." According to the Office Action, this is at least taught by paragraph 6.

Paragraph 6 generally discusses calculating advantages of going forward with a proposal. Nowhere, however, in paragraph 6, or elsewhere in Perry, is it taught or suggested that any recommendation whether to proceed is based upon the information technology capabilities of the entity formed according to the proposed venture transaction. A general teaching that calculating advantages of going forward with a proposal is possible is insufficient. Instead, Applicant submits that the Examiner must show where Perry teaches that the decision whether to proceed is based upon the information technology capabilities of the entity formed according to the proposed venture transaction, as claimed by Applicant.

For at least these reasons, Applicant submits that claim 1 is allowable over Perry. Claim 12 contains similar recitations, and should be allowable for similar reasons.

Claims 2-11 and 13-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Perry in view of Johnson et al. Johnson, however, does not cure the noted deficiencies of Perry with respect to claims 1 and 12, and thus claims 2-11 and 13-19 should be allowable based at least on their dependency from allowable independent claims.

Claim 20 contains similar recitations to those noted with respect to claims 1 and 12. Accordingly, claim 20 should be allowable over Perry and Johnson for at least the reasons that claims 1 and 12 are allowable over Perry and Johnson.

Based on the amendments and remarks presented herein, all claims are believed to be in condition for allowance. Reconsideration and allowance are respectfully requested. If the Examiner has any questions about the amendments or remarks, or has any other reason to contact Applicant to further the prosecution of this application, he is invited to contact the undersigned at the number provided below.

Respectfully submitted,

CHEN et al.

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